

Application of TANAKA - Serial No. 10/025,960 - Atty. Dkt. 008312/0290599

JAN 06 2005

REMARKS

Reconsideration and the timely allowance of the pending claims, in view of the forgoing amendments and the following remarks, are respectfully requested.

Prior to this Amendment, claims 1-8 were pending. By the Amendment, claims 2-8 are amended. Claim 1 has been canceled without prejudice or disclaimer of the subject matter contained therein. No claims have been newly added. Accordingly, after entry of this Amendment, claims 2-8 will remain pending.

I. Interview Summary

Before addressing the rejections set forth in the Office Action, the Applicant would like to thank the Examiner for the courtesies extended during the telephonic interview, with the undersigned, which was conducted on January 5, 2005. During that interview, the Examiner and the undersigned discussed claim language that the Examiner believed should overcome the rejection under 35 U.S.C. § 112, second paragraph. In particular, the Examiner and the undersigned discussed amending the claims to more clearly recite the relationship(s) between the various characteristics associated with aspects of the claimed invention. The Amendments presented herein reflect the substance of that interview. The Examiner indicated that, with a more specific recitation as outlined above, and conditioned upon his review of the language, he may consider the claims to be in condition for allowance. The Examiner also indicated that, should minor corrections to the claims be required after this submission, he would contact the undersigned.

II. Specification

The disclosure was objected to because of an alleged informality of the heading in page 5, line 11 in the specification. However, in the previous amendment, the Applicant changed the heading "BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING" to "BRIEF DESCRIPTION OF THE DRAWINGS" in accordance with the Examiner's suggestion (page 2 in the Amendment of June 15, 2004). Accordingly, since this change has already been made, reconsideration and withdrawal of the objection are respectfully requested.

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III. Allowable Subject Matter

In the Office Action, claim 8 was objected to as dependent upon a rejected base claim. The Examiner stated that claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in the Office Action and to include all of the limitations of the base claim and any intervening claims. The Applicant would like to thank the Examiner for the indication of allowable subject matter.

The Applicant has rewritten claim 8 as an independent form including all the limitations of the base claim 1 and deleted the language “wherein the read head element includes a giant magnetoresistive (GMR) element, said giant magnetoresistive being configured to have a linear magnetic field response characteristic, in response to a reproduction magnetic field from the disk medium, to output a signal waveform without distortion” to overcome the rejection under 35 U.S.C. 112, second paragraph, set forth in the Office Action. Also, the Applicant amended the language “GMR” in claim 8 as “giant magnetoresistive (GMR)” for clarity, which does not change the scope of protection, either literally or under the doctrine of equivalents. Thus, the Applicant respectfully submits that the amended claim 8 is now in condition for allowance. Accordingly, reconsideration and withdrawal of the objection of claim 8 are respectfully requested.

IV. Claim Rejections – 35 U.S.C. §112

Claims 1-8 were rejected under 35 U.S.C. §112, second paragraph. The rejection is respectfully traversed.

The Examiner rejected claim 1 under 35 U.S.C. 112, second paragraph, finding that the language “being configured to have a linear magnetic field response characteristic, in response to a reproduction magnetic field from the disk medium, to output a signal waveform without distortion” is indefinite and that the language remains deficient as not setting forth sufficient structure to produce the claimed results. (Page 2, lines 15-19 in the Final Office Action). With regard to claim 1, the Applicant has canceled claim 1 and, thus, the rejection is rendered moot.

With regard to claim 8, the Applicant has rewritten claim 8 as an independent form including all the limitations of the base claim 1 and deleted, in part, the language

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"wherein the read head element includes a giant magnetoresistive (GMR) element, said giant magnetoresistive being configured to have a linear magnetic field response characteristic, in response to a reproduction magnetic field from the disk medium, to output a signal waveform without distortion" to overcome the rejection.

With regard to claim 7, the Applicant has amended claim 7 to depend on claim 8.

With regard to claims 2-6, the Examiner stated that claims 2-6 do not claim sufficient structure so as to particularly set forth applicant's invention in order to satisfy the recited results: e.g., for claim 2, what is this hypothetical "linear magnetic field response range"; for claim 3, what is this hypothetical "maximum magnetic field value"; for claim 4, what is the hypothetical "maximum magnetic field value o" of the linear response; for claim 5, what is the "maximum magnetic field" of the disk medium (Page 2, line 19 – page 3, line 4 in the Final Office Action). Claims 2-6 have been amended to depend on claim 8. Moreover, these claims have been amended consistently with the substance of the telephonic interview on January 5, 2005. As a result, the Applicant respectfully submits that claims 2-6 satisfy the requirements for patentability. Accordingly, reconsideration and withdrawal of the rejection of claims 2-8 under 35 U.S.C. §112, second paragraph, are respectfully requested.

V. Claim Rejections – 35 U.S.C. §102

Claims 1-6 were rejected under 35 U.S.C. §102(b) based on Akiyama *et al.* (U.S. Pat. No. 5,815,342) ("Akiyama"). Claim 1 has been canceled and, thus, the rejection is rendered moot. Claims 2-6 have been amended to depend on claim 8. Thus, claims 2-6 are patentable over Akiyama at least by virtue of their dependency on the allowable claim 8. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

VI. Claim Rejections – 35 U.S.C. §103(a)

Claim 7 was rejected under 35 U.S.C. §103(a) based on Akiyama in view of Hoshiya *et al.* (U.S. Pat. No. 5,933,297) ("Hoshiya"). Claim 7 has been amended to depend on claim 8. Thus, claim 7 is patentable over Akiyama and Hoshiya at least by

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virtue of its dependency on the allowable claim 8. Accordingly, reconsideration and withdrawal of the rejection of claim 7 are respectfully requested.

VII. Conclusion

In view of the forgoing, the Applicant respectfully requests that the Examiner withdraw the rejections and objections and pass this application quickly to issue.

If there are any fees due in connection with the filing of this paper that are not otherwise accounted for, please charge our Deposit Account No. 03-3975 and refer to Order No. 008312/0290599.

Respectfully submitted,

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Date: January 6, 2005

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